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Serial No.: 10/682,597

Confirmation No.: 9772

Filed: 9 October 2003

For: MULTILAYER PROCESSING DEVICES AND METHODS

The 35 U.S.C. §102 Rejection

Claims 1-30 were rejected under 35 U.S.C. §102 as being anticipated by Harms et al. (U.S. Application Publication No. 2002/0048533). Applicants respectfully submit that a proper anticipation rejection has not been established with respect to claims 1-30. Reconsideration and withdrawal of the asserted anticipation rejection are, therefore, respectfully requested.

In support of this anticipation rejection it is asserted that element 18 of the Harms et al. reference is equivalent to the recited transmissive layer and that element 16 of the Harms et al. reference is equivalent to the recited control layer. It is further asserted that paragraph [099] of the Harms et al. reference teaches "coating layer (16) with a metal foil to control or block the light transmission and the metal foil coating has been read on the claimed 'cover sheet.'" *Office Action*, page 5 (August 27, 2008). Applicants disagree that this interpretation supports the asserted anticipation rejection and respectfully request reconsideration and withdrawal of this rejection for the following reasons.

Applicants have reproduced paragraph [099] of Harms et al. below.

[0099] It may also be preferred that at least one of the first and second sides 16 and 18 include a metallic layer, e.g., a metallic foil. If provided as a metallic foil, the side may include a passivation layer on the surfaces that face the interiors of the loading structures 30, main conduits 40, feeder conduits 42, and/or process chambers 50 to prevent contamination of the sample materials by the metal.

In addition, Figure 4 of the Harms et al. reference, which is the subject of paragraph [099], is reproduced below.

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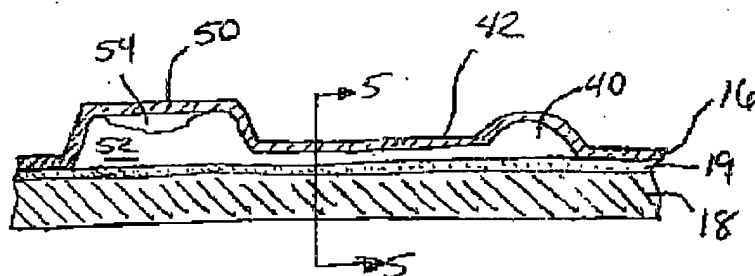
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Applicants submit that the asserted interpretation of the teachings of Harms et al. does not establish a proper anticipation rejection of claims 1-30 for at least the following reasons.

Claims 1-12

Independent claim 1 recites, *inter alia*, a control layer that blocks selected light, a transmissive layer attached to a first major surface of the control layer, and a cover sheet attached to the second major surface of the control layer. In other words, the control layer is located between the transmissive layer and the cover sheet.

In contrast, the interpretation of Harms et al. that is offered in support of this rejection identifies element 16 as the control layer, element 18 as the transmissive layer, and a metal foil coating on element 16 as the cover sheet. That interpretation does not, however, support an anticipation rejection of claims 1-12.

As noted above, independent claim 1 recites that the control layer "blocks selected light." In the asserted interpretation of Harms et al., however, there is no explicit teaching that element 16 would, itself, block selected light as does the control layer of independent claim 1. Although a metal foil coating on element 16, identified in the rejection as the "cover sheet," could presumably block the transmission of light, that metal foil coating is identified as the cover sheet, not the control layer. Rather, element 16 is identified as the control layer and, therefore, it is element 16 that must block the selected light to support the asserted anticipation rejection.

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If it is the intent of the Office to assert that element 16 of Harms et al. inherently functions as the control layer, then Applicants respectfully request reconsideration and withdrawal of the anticipation rejection of claims 1-12 because the standards for a rejection based on inherency have not been met.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV), p. 2100-47, 8th Ed., Rev. 6, (Sept. 2007) (emphasis in original) (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993)). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.* at p. 2100-48 (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

In connection with the anticipation rejection of claims 1-12 based on Harms et al., no basis in fact or technical reasoning has been provided to establish that element 16 of Harms et al., if coated with a metal foil that serves as the cover sheet, would necessarily block selected light. As a result, any assertion that the inherent teachings of Harms et al., in view of the interpretation offered in support of this rejection, does not meet the standards for an anticipation rejection based on inherency.

For at least these reasons, Applicants respectfully submit that a proper anticipation rejection of claims 1-12 based on Harms et al. has not been established. Reconsideration and withdrawal of the anticipation rejection of claims 1-12 are, therefore, respectfully requested.

Claim 13

Applicants respectfully request reconsideration and withdrawal of the anticipation rejection of independent claim 13 for the same reasons advanced above with respect to claims 1-12. All of the features recited in claim 1 and relied on to show the failure of the asserted anticipation rejection with respect to claims 1-12 are also found in independent claim 13. As a

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result, reconsideration and withdrawal of the anticipation rejection of claim 13 are also appropriate.

In addition, however, it must be noted that independent claim 13 recites a variety of features that are not discussed in this anticipation rejection. For example, claim 13 recites that "each of the process chamber structures comprises a void formed through the first major surface and the second major surface of the control layer." No portion of Harms et al. has been identified as teaching such a feature.

Independent claim 13 also recites "a conduit formed between the cover sheet and the control layer." No portion of Harms et al. has been identified as teaching such a feature.

For at least these reasons, Applicants respectfully submit that a proper anticipation rejection of claim 13 based on Harms et al. has not been established claim 13. Reconsideration and withdrawal of the anticipation rejection of claim 13 are, therefore, respectfully requested.

Claims 14-30

Applicants also respectfully request reconsideration and withdrawal of the anticipation rejection of independent method claim 14 and its dependent method claims 15-30.

Independent method claim 14 recites a method of manufacturing a sample processing device that includes, *inter alia*, providing a body that includes a control layer that blocks selected light, with a transmissive layer attached to a first major surface of the control layer. The method further recites attaching a cover sheet to the second major surface of the control layer. In other words, attaching the cover sheet leaves the control layer located between the transmissive layer and the cover sheet.

As a result, all of the arguments presented with respect to this anticipation rejection as applied to claims 1-12 apply equally to the anticipation rejection of method claims 14-30. As a result, reconsideration and withdrawal of the anticipation rejection of method claims 14-30 are also appropriate.

In addition, however, it must be noted that method claims 14-30 recite features that are not discussed in this anticipation rejection. For example, method claim 16 recites "forming a

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void through the control layer." No portion of Harms et al. has been identified as teaching such a feature.

Further, method claim 20 recites that "the conduit is formed between the cover sheet and the control layer." No portion of Harms et al. has been identified as teaching such a feature.

For at least these reasons, Applicants respectfully submit that a proper anticipation rejection of method claims 14-30 based on Harms et al. has not been established.

Reconsideration and withdrawal of the anticipation rejection of claims 14-30 are, therefore, respectfully requested.

Summary

The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted by

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26th day of December, 2008, at 11:55 AM (Central Time).

By: 
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